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USSN 09/743,385

CONDITIONAL PETITION FOR EXTENSION OF TIME

If entry and consideration of the amendments above requires an extension of time, Applicants respectfully request that this be considered a petition therefor. The Commissioner is authorized to charge any fee(s) due in this connection to Deposit Account No. 14-1263.

ADDITIONAL FEE

Please charge any insufficiency of fees, or credit any excess, to Deposit Account No. 14-1263.

REMARKS

Applicants respectfully request reconsideration and allowance of this application in view of the amendments above and the following comments.

Amendments have been made to all of the previous claims. A clean copy of the claims is presented above. A mark-up showing the changes that have been made to the claims using brackets and underlining is attached.

Applicants do not believe that the amendments to the previous claims introduce any new matter. Most of the amendments are clearly formal, clarifying amendments. With respect to the amendment to claim 1 that the metallocene-polyethylene nonwoven is nonadhesive, Applicants

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submit that this amendment finds clear support throughout the specification, wherein Applicants have shown that suitable nonwovens can be formed from nonadhesive components alone. *See, e.g., In re Anderson*, 176 USPQ 331, 336 (CCPA 1973), for the proposition that in determining whether an amendment to a claim constitutes new matter, the question is not whether the added word is a word that is used in the application as filed, but whether the concept embodied by the added word is present in the original specification. Since the specification conveys the concept of metallocene-polyethylene nonwovens prepared from nonadhesive components, the recitation in claim 1 of nonadhesive metallocene-polyethylene nonwovens does not introduce new matter.

In addition, two new claims 10 and 11 are added. Applicants do not believe that any new matter is introduced by the addition of these claims. Claim 10 is supported by original claim 2. Claim 11 is supported by original claim 3.

Claims 2, 4, 7 and 8 were rejected under 35 USC §112, second paragraph, as being indefinite. In response, Applicants have amended these claims in a manner that Applicants believe clearly overcomes the Examiner's concerns. Thus, the "particular" embodiments of claims 2 and 4 have been made the subject of new claims 10 and 11, respectively. Claim 7 has been clarified as to "a reverse side." Finally, claim 8 has been amended to recite proper Markush language.

For the record, Applicants emphasize that although claims 2, 4, 7 and 8 were amended to

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overcome this rejection, and, therefore, might be considered to have been amended for a reason substantially related to patentability, a fair reading of the amended claims will reveal that the departures from the previous claims were for clarification purposes only, and that Applicants did not narrow the claims in any material respect. This is also true of the amendments made to the other unrejected claims, which were mainly purely clarifying amendments made to place the claims in better form. Therefore, Applicants submit that the amended claims are entitled to the full range of equivalents.

Claims 1-9 were rejected under 35 USC §103(a) as being obvious over WO 97/42922 ("Mashiko") combined with Yang et al. ("Yang"), U.S. Patent No. 5,681,301. In response, Applicants respectfully request that the Examiner reconsider and withdraw this rejection.

According to *Manual of Patent Examining Procedure* ("MPEP") § 2143:

"To establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest *all* the claim limitations."

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The combination of references, as set forth by the Examiner, fails to teach or suggest all of the instant claim limitations. Therefore, the cited combination of references fails to make out a *prima facie* case that the claimed invention would have been obvious to persons skilled in the art at the time the present invention was made.

The thrust of this rejection, as stated by the Examiner in the next-to-last sentence on page 3 of the Office Action, is that a person having ordinary skill in the art would have been motivated to substitute the material of Yang into the bandage of Mashiko, and, thereby, be put in possession of the present invention. However, the instant claims expressly require the use of a metallocene-polyethylene *nonwoven*, whereas the Examiner concedes that Yang teaches a metallocene-polyethylene *woven*. Consequently, substitution of Yang's material into Mashiko's bandage will *not*, in fact, achieve the instantly claimed invention. Instead, substitution of Yang's material into Mashiko's bandage will yield a bandage having a *woven* backing, which is *not* what is instantly claimed.

In short, Applicants believe that this rejection is in error, and Applicants respectfully request that the Examiner reconsider and withdraw this rejection altogether. An early notice that this rejection has been reconsidered and withdrawn is earnestly solicited.

Claims 1-9 were rejected under 35 USC §103(a) as being obvious over either Joseph et al. ("Joseph"), U.S. Patent No. 6,107,219, or Riedel et al. ("Riedel"), U.S. Patent No. 6,133,173.

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In response, Applicants respectfully request that the Examiner reconsider and withdraw this rejection as well.

Both Joseph and Riedel describe products comprising nonwoven materials *made from pressure-sensitive adhesive fibers in addition to, possibly, metallocene-polyethylenes so that the nonwoven material itself is adhesive*. These products are, thus, fundamentally different from the instantly claimed products, which comprise *nonadhesive* metallocene-polyethylene nonwovens. There is absolutely nothing in either Joseph or Riedel that would have motivated persons skilled in the art to ignore the teachings of these references and make and use nonadhesive metallocene-polyethylene nonwovens as backing materials. In fact, because Joseph and Riedel expressly teach the use of adhesive nonwoven materials, they necessarily teach away from the use of nonadhesive nonwoven materials.

In short, Applicants submit that the Examiner would be fully justified to reconsider and withdraw this rejection as well. An early notice that this rejection has been reconsidered and withdrawn is earnestly solicited.

Applicants believe that the foregoing constitutes a bona fide response to all outstanding objections and rejections.

Applicants also believe that this application is in condition for immediate allowance.

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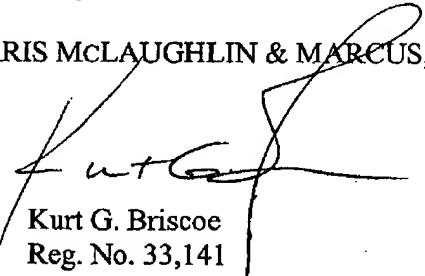
However, should any issue(s) of a minor nature remain, the Examiner is respectfully requested to telephone the undersigned at telephone number (212) 808-0700 so that the issue(s) might be promptly resolved.

Early and favorable action is earnestly solicited.

Respectfully submitted,

NORRIS MCLAUGHLIN & MARCUS, P.A.

By


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CERTIFICATE OF FACSIMILE TRANSMISSION

I hereby certify that the foregoing Amendment under 37 CFR § 1.111 and the attached Mark-Up Showing the Changes Made in the Previous Claims to Yield the Claims as Amended Above and the accompanying Petition for Extension of Time (13 pages total) are being facsimile transmitted to the United States Patent and Trademark Office on the date indicated below:

Date: December 24, 2002

By:


Kurt G. Briscoe

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**MARK-UP SHOWING THE CHANGES MADE IN THE PREVIOUS CLAIMS TO
YIELD THE CLAIMS AS AMENDED ABOVE**

--1. (Twice Amended) A combination comprising a nonadhesive metallocene-polyethylene nonwoven as backing material and a self-adhesive coating, [the] said backing material being provided on at least one side with said self-adhesive coating.--

--2. (Once Amended) Combination according to Claim 1, [characterized in that] wherein the metallocene-polyethylene nonwoven has a basis weight of from 40 to 200 g/m², [in particular from 60 to 120 g/m²,] and/or a thickness of from 0.1 to 0.6 mm[, in particular from 0.2 to 0.5].--

--3. (Once Amended) Combination according to Claim 1, [characterized in that] wherein the metallocene-polyethylene nonwoven has an ultimate tensile strength elongation lengthwise of from 300 to 700% and/or an ultimate tensile strength elongation crosswise of from 250 to 550%.--

--4. (Once Amended) Combination according to Claim 1, [characterized in that] wherein the [fibres] fibers of the metallocene-polyethylene nonwoven

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have a diameter of from 3 to 50 μm [, in particular from 10 to 25 μm].--

--5. (Once Amended) Combination according to Claim 1, [characterized in that] wherein the [polymer employed] metallocene-polyethylene is a copolymer of ethylene and an α -olefin having a carbon number from C_4 to C_{10} , the [polyolefin] metallocene-polyethylene having a melt index of between 1 and 50 g/(10 min) and a density of from 860 to 900 kg/m^3 .--

--6. (Once Amended) Combination according to Claim 1, [characterized in that] wherein the self-adhesive coating consists of a [commercially customary,] pressure-sensitive adhesive composition based on acrylate or on rubber.--

--7. (Once Amended) Combination according to Claim 1, [characterized in that the] wherein a reverse side of the metallocene-polyethylene nonwoven has been given an anti-adhesive treatment.--

--8. (Once Amended) Combination according to Claim 1, which is in the form of one member selected from the group consisting of a rapid dressing, a prefabricated surgical dressing, a roll plaster and a tape dressing[as rapid dressings, prefabricated surgical dressings, roll plasters and/or tape dressings].--

--9. (Once Amended) Combination according to Claim 1, which is in the form of an [as] adhesive tape.--